

REMARKS/ARGUMENTS

Claims 25–38 are pending in the above-captioned application and all stand rejected. Applicants thank the Examiner for her courtesies in speaking with the below-signed attorney during a telephonic interview on November 9, 2005, regarding the application and, specifically, regarding claim 36. With this paper, claim 36 has been amended in keeping with the discussion, and claim 38 has been canceled. In addition, claims 25, 26, and 37 have been amended. No new matter was added with the amendment.

I. Objection to the drawings

The drawings were objected to under 37 CFR 1.83(a) as not showing every feature of the invention specified in claim 36. Claim 36 has been amended to overcome this objection.

The Examiner states on page 2 of the Office action that the first and second microfluidic chips recited in the previously presented claim 36 must be shown or these features canceled from the claim. Applicants wish to point out that the microfluidic chips recited in claim 36 were not intended to be elements of the claim but were, rather, intended to be workpieces. The term “workpiece” is defined in *Landis on Mechanics of Patent Claim Drafting, Fifth Edition*, page 3-6, as “a thing that the invention uses or operates upon and perhaps changes.” Nonetheless, the claim has been amended to avoid any confusion.

The Examiner also states that the drawings fail to show “a second top unit...” Applicants respectfully disagree. A first top unit is shown in Figure 1 at 104, and a second top unit is shown in Figure 3 at 305, top unit 104 having a configuration different from that of top unit 305.

II. Claim rejections under 35 U.S.C. § 112, second paragraph

Claims 36–38 were rejected as being indefinite for failing to particularly point out and distinctly the subject matter that Applicants regard as the invention. Claim 36 has been amended to incorporate the limitation of previously presented claim 38, thereby clarifying that only one of the top units is attached to the base unit at any one time, the first top unit being exchanged for the second top unit or vice versa. Replacement of the erroneous term “module”

with the correct term “top unit” provides additional clarity. Claim 37 becomes definite by virtue of depending from currently amended claim 36. Claim 38 has been canceled, the limitation of claim 38 being incorporated into claim 36.

An additional amendment to claim 36, as well as to claims 25, 26, and 37, replaces the term “pressurized fluid source” with the term “pressure source.” Support for this amendment can be found throughout the specification, for example on page 7, lines 15–19; page 9, line 25, through page 10, line 3; page 10, lines 30 and 31; and page 12, lines 17–19. The element “a priming fluid” has been added to both claim 36 and claim 25. Support for this amendment is also found throughout the specification, for example on page 7, lines 7 and 8; page 8, lines 1 and 2; and page 13, lines 1, 2, 28 and 29. Thus, no new matter has been added.

III. Claim rejections under 35 U.S.C. § 102(b) as being anticipated by Unno et al.
(US 6,495,104 B1)

Claims 25–30 and 32–38 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Unno et al. (US 6,495,104 B1). This rejection is respectfully traversed. “[F]or anticipation under 35 U.S.C. § 102, a single reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.” MPEP § 706.02. “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, USPQ2d 1913, 1920 (Fed. Cir. 1989).

With regard to currently amended independent claims 25 and 36, at a minimum, Unno et al. do not teach a system for priming a microfluidic chip that comprises a priming fluid. The system taught by Unno et al. comprises instrumentation for using a microfluidic device in a variety of applications (e.g., those listed in column 4, lines 35–41). The system does not include a priming fluid because a microfluidic device (i.e., the workpiece of the system taught by Unno et al.) will already have been primed using, for example, one of the prior art methods or systems described in the background section of Applicants’ specification. Therefore, a system as claimed by Applicants will be used to prime a microfluidic chip prior to that chip being used in a system such as is taught by Unno et al.

Thus, Unno et al. do not teach every aspect of the claimed invention either explicitly or impliedly, nor do they show the identical invention claimed by Applicants in as complete detail as is contained in amended independent claims 25 and 36. Withdrawal of the rejections of claims 25 and 36 under U.S.C. § 102(b) as being anticipated by Unno et al. is, therefore, respectfully requested.

Claims 26–30 and 32–35 depend directly or indirectly from amended independent claim 25, while claim 37 depends directly from amended independent claim 36. Therefore, Applicants respectfully submit that these dependent claims are allowable for at least the same reasons as set forth herein with respect to amended independent claims 25 and 36. Withdrawal of the rejections of dependent claims 26–30, 32–35, and 37 under U.S.C. § 102(b) as being anticipated by Unno et al. is also respectfully requested.

IV. Claim rejections under 35 U.S.C. § 103(a) as being unpatentable over Unno et al. (US 6,495,104 B1) in view of Schwartz (US 5,547,555)

Claim 31 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Unno et al. (US 6,495,104 B1) in view of Schwartz (US 5,547,555). This rejection is traversed. To warrant rejection under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art. See MPEP § 2142.

Claim 31 is dependent upon currently amended independent claim 25 and, as a result, includes all of the limitations of claim 25. As demonstrated above, Unno et al. do not teach or suggest all of the limitations of claim 25. Therefore, Unno et al. cannot teach or suggest all of the limitations of claim 31.

Schwartz, like Unno et al., teaches a system (or apparatus) for performing an application. In the invention of Schwartz, the application is detecting and quantifying an analyte in a sample of fluid. See column 1, lines 5–7. Thus, at a minimum, Schwartz does not teach or suggest a system that comprises a priming fluid and so cannot remedy the failure of Unno et al. to teach this limitation.

Thus, combining the two cited references does not teach or suggest all of the limitations of claim 31. Withdrawal of the rejection of claim 31 as being unpatentable over Unno et al. in view of Schwartz is respectfully requested.

10/084,245 filed 2/27/2002
Kennedy, et al.
Reply to Office Action of August 17, 2005

Conclusion

For the foregoing reasons, Applicants believe all the pending claims are in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned attorney.

Respectfully submitted,



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Signed:  _____